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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,385	10/11/2002	Bernd Hans Faigle	P6845.1US	2778
30008 7590 12/24/2003			EXAMINER	
GUDRUN E. HUCKETT			LE, DANG D	
LONSSTR. 53			ART UNIT	
WUPPERTAL, 42289			PAPER NUMBER	
GERMANY			2834	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,385

Applicant(s)

FAIGLE, BERND HANS

Examiner

Dang D Le

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- Page 3, paragraph 8, line 5, spell out "NC".
- Page 4, paragraph 13, lines 2-3, correct "Acontrol path@".

Appropriate correction is required.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

3. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is noted that claim 12 is written to depend on claim 12. It is considered that claim 12 depends on claim 1 in this office action.

Claim Rejections - 35 USC § 112

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 35, it is not clear what "an NC-control" is.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshina et al. (3,777,587).

Regarding claims 1 and 35, Hoshina et al. show a rotary machine element (Figures 1 and 3) comprising:

- At least one functional part (7) performing movements into stop positions (along shaft 4), which stop positions are nominal stop positions (leftmost and rightmost positions) or mechanical terminal stop positions and are functionally

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correlated (nut 7 can not be at left side without first being at right side and vice versa);

- At least one position sensor (24, 27) configured to detect individual actual position values of the stop positions independently (because of signal e) from one another;
- Wherein the at least one position sensor (24, 27) is located in a control path between the at least one functional part (7) and an NC control (31);
- Wherein the control path is active in positions between the nominal stop positions, the mechanical terminal stop positions, or the nominal stop positions and the mechanical terminal stop positions.

8. Claims 1 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein et al. (4,799,839).

Regarding claims 1 and 35, Bernstein et al. show a rotary machine element (Figure 1) comprising:

- At least one functional part (29, 30, 4, 7, 9) performing movements into stop positions (to cut and to hold work piece), which stop positions are nominal stop positions or mechanical terminal stop positions and are functionally correlated;
- At least one position sensor (12, 42) configured to detect individual actual position values of the stop positions independently from one another;

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- Wherein the at least one position sensor (12, 42) is located in a control path between the at least one functional part (29, 30, 4, 7, 9) and an NC control (33);
- Wherein the control path is active in positions between the nominal stop positions, the mechanical terminal stop positions, or the nominal stop positions and the mechanical terminal stop positions.

9. Claims 1, 2, 5, 12-23, 26, 27, 33-43, and 54-58 are rejected under 35

U.S.C. 102(b) as being anticipated by Carpenter et al. (4,431,954).

Regarding claim 1, Carpenter et al. show a rotary machine element (Figure 1) comprising:

- At least one functional part (12) performing movements into stop positions (FE and CD), which stop positions are nominal stop positions (FE and CD) or mechanical terminal stop positions and are functionally correlated;
- At least one position sensor (24) configured to detect individual actual position values of the stop positions independently from one another;
- Wherein the at least one position sensor (24) is located in a control path between the at least one functional part (12) and an NC control (23);
- Wherein the control path is active in positions between the nominal stop positions (FE and CD), the mechanical terminal stop positions, or the nominal stop positions and the mechanical terminal stop positions.

Regarding claims 2, 5, 12-23, 26, 27, 33-43, and 54-58, it is noted that Carpenter et al. also show all of the limitations of the claimed invention.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 4, 6-11, 24, 25, 28-32, 34, and 44-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter et al. in view of Ishizuka et al. (4,087,890).

Regarding claim 3, Carpenter et al. show all of the limitations of the claimed invention except for the hydraulic medium.

Ishizuka et al. teach to use hydraulic medium for the purpose of making a compound lathe.

Since Carpenter et al. and Ishizuka et al. are all from the same field of endeavor; the purpose disclosed by one inventor would have been recognized in the pertinent art of the others.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use hydraulic medium as taught by Ishizuka et al. for the purpose discussed above.

Regarding claims 4, 6-11, 24, 25, 28-32, 34, and 44-58, it is noted that Ishizuka et al. show all of the limitations of the claimed invention.

Information on How to Contact USPTO

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dang D Le whose telephone number is (703) 305-0156. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

12/14/03

A handwritten signature in black ink, appearing to read 'Dang D Le', with a stylized flourish at the end.

**DANGLE
PRIMARY EXAMINER**